IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14364US04)

In the Application of:	Examiner: Albert T. Chou
Kubler et al.	Group Art Unit: 2416
U.S. Patent: 7,633,934	Confirmation No.: 8847
Issue Date: December 15, 2009	/Kevin E. Borg/
Serial No.: 10/760,057	Transmitted via the Office electronic filing system October 18, 2010.
Filed: January 16, 2004	
For: HIERARCHICHAL DATA COLLECTION NETWORK SUPPORTING PACKETIZED VOICE COMMUNICATIONS AMONG WIRELESS TERMINALS AND TELEPHONES	

APPLICATION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) INDICATED IN THE PATENT (37 CFR § 1.705(d))

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

The applicant respectfully requests reconsideration of the patent term adjustment indicated on the cover page of the patent ("the patent PTA decision"), to the extent indicated in the following discussion. The total PTAs indicated in this paper also reflect aspects of the current USPTO Patent Term Adjustment calculation on PAIR that have already been the subject of an earlier request for recalculation under 37 CFR § 1.705(b).

This application for reconsideration of the patent PTA decision is being filed within one month of the Letter Regarding Patent Term Adjustment mailed September 17, 2010.

This application for reconsideration of the patent PTA decision is accompanied by the fee set forth in § 1.18(e) ($200).

This application for reconsideration of the patent PTA decision includes below a statement of the facts involved in sufficient detail to allow the United States Patent and Trademark Office (USPTO) to reach the correct patent term adjustment respecting the disputed items that arose after allowance.

The Applicant's calculation shows that the correct patent term adjustment, accounting for previously disputed and presently disputed items, should be 1277 days.

The basis under § 1.702 and 37 CFR § 1.705(d) for the adjustment is as follows.

Positive Patent Term Adjustment

Three Year Guarantee
(35 USC § 154(b)(1)(B))

The USPTO calculation of the patent term adjustment under the three-year deadline for issuing a patent after its filing date was 630 days. The Applicant disagrees with this determination because the patent term adjustment on this ground should instead be 631 days, minus 0 days consumed by an appeal, for a net adjustment of 631 days.

Specifically:

- the actual filing date of the application was January 16, 2004,
- the third anniversary of the actual filing date was January 16, 2007,
- the first request for continued examination of the application (RCE) under 35 USC 132(b) was filed on October 8, 2008,
- the first RCE was filed 631 days after the third anniversary of the actual filing date, which is the appropriate patent term adjustment on this ground.

Based on experience with other patent term adjustment calculations, the applicant understands the USPTO's position on this point to be that the patent term adjustment under the Three Year Guarantee (35 USC § 154(b)(1)(B)) ends on the day before the first RCE is filed. The apparent rationale is that the day the RCE is filed is Day 1 that the patent term adjustment has stopped accumulating.

The applicant respectfully submits that this position is inconsistent with the statute and other USPTO calculations based on events that interrupt the accumulation of patent term adjustments.

First addressing consistency with the statute, the USPTO has determined that time for purposes of assessing a PTA is calculated in two ways: one way when the statute calls for calculation of a delay or interval between two events, and the other way when the statute calls for calculation of the number of days on which a proceeding is pending. This differentiation between the two calculations is understood to turn on the words of the statute. The only part of the statute that calls for a determination of the number of days on which a proceeding is pending is 35 USC § 154(b)(1)(C), which states:

> **35 USC § 154(b)(1)(C)** GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to-
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> (i) a proceeding under section 135(a);
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> (ii) the imposition of an order under section 181; or
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> (iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

To provide a simple example, if an appeal were filed on Monday and decided on Friday, the appellate review was pending on Monday, Tuesday, Wednesday, Thursday, and Friday, thus on five days.

In contrast, the part of the statute relevant to an RCE capping the accrual of a PTA under the three year guarantee is 35 USC § 154(b)(1)(B), which states:

> **35 USC § 154(b)(1)(B)** GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office

to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Reverting again to the above simple example, if an appeal were filed on Monday and decided on Friday, the "time consumed by appellate review" is calculated by setting Monday equal to Day 0, Tuesday equal to Day 1, Wednesday equal to Day 2, Thursday equal to Day 3, and Friday equal 4, thus an elapsed time of FOUR, days, not FIVE as in the preceding example that called for calculation of the number of days a proceeding was pending. In other words, "time consumed by appellate review" calls for the almost universal system for calculation of deadlines in courts and the USPTO, where the starting event from which the deadline is calculated is Day 0, and the succeeding days are assigned consecutive numbers until the day the deadline is reached.

The "time consumed by continued examination," like the "time consumed by [an appeal, an interference, or a secrecy order]," all under 35 USC § 154(b)(1)(B), is expressed in different words than "each day of the pendency of the proceeding order, or review," all under the provisions of 35 USC § 154(b)(1)(C), thus these two expressions in different parts of the same statutory section can be assumed to have different meanings as explained above.

In most situations, this is how the USPTO interprets the statute. For example, again based on USPTO petition practice experienced by the applicant, when a successful appeal is prosecuted in an application that was pending more than three years, the USPTO subtracts appeal time from accrual of time under

the three year guarantee by treating the date the Notice of Appeal is filed as Day 0, the date n days later when the appeal decision is mailed as Day n, simply determines that the appeal has been pending for n days, and subtracts n from the accrued time under the 3-year rule. To calculate the PTA accrued due to the prosecution of a successful appeal, however, the USPTO treats the starting date as Day 1, the date n days later when the appeal decision is mailed as Day n + 1, and determines that there were n+1 days on which the appeal was pending, and that is the PTA for appeal delay.

Now addressing consistency with other calculations, the subtraction from the three-year guarantee for an RCE is based on 35 USC § 154(b)(1)(B)(i), which calls for a subtraction based on "(i) any time consumed by continued examination of the application requested by the applicant under section 132(b)." The subtraction from the three-year guarantee for an appeal is based on parallel language of 35 USC § 154(b)(1)(B)(ii), which calls for a subtraction based on "(ii) … any time consumed by appellate review by the Board of Patent Appeals and Interferences." This parallel language calls for RCE subtraction and appeal subtraction to be based on the same method of time computation. But they are not.

As pointed out above, the filing date of an RCE is counted as Day 1 of reduction of PTA, so time stops accruing on the three-year guarantee the day before the RCE is filed. But the filing date of a Notice of Appeal is counted as Day 0 of reduction of PTA, so time stops accruing on the three-year guarantee the day the RCE is filed. These positions are inconsistent interpretations of the same statutory language. The RCE computation is in error because the statute calls for routine computation of time in both situations, with the starting day of a period counted as Day 0, while the USPTO position is that the day the RCE is filed is Day 1.

Another example of an inconsistency resulting from ending the three-year delay the day before the first RCE was filed is the following. The patent term adjustment under the Three Year Guarantee permanently stops accruing or is "capped" in two situations: when the patent issues or when the first RCE is filed. Based on experience with other patent term adjustment calculations, the

applicant understands the USPTO policy respecting issue of the patent is that the issue date of the patent is Day 0 that the patent term adjustment stops accruing. In other words, the PTA on this ground is capped on the day the patent issues, not the day before the patent issues. Exactly analogously to the issue date of the patent, the date an RCE is filed is a triggering event that caps the PTA. No reason is apparent why the issue date of a patent is Day 0 on which the PTA has been capped and the filing date of an RCE is day 1 after the PTA has been capped.

For these reasons, the USPTO policy for calculation of the effect of filing an RCE on accrual of the three-year guarantee is in error, and provides a PTA one day shorter than it should be. Correction is respectfully requested.

Net Patent Term Adjustment

The changes requested by the Applicant to the USPTO patent term adjustment determination in the patent PTA decision are as follows:

Positive Patent Term Adjustment

- **Three Year Guarantee (35 USC § 154(b)(1)(B))**

	Patent Term Adjustment (days)
USPTO Calculation	630
Applicant Calculation	631

Conclusion

The Applicant requests modification of the patent term adjustment as indicated above. The patent term adjustment proposed by the Applicant is thus 1277 days.

Please charge any fees or credit any overpayment of fees presently required to McAndrews, Held & Malloy, Ltd., Deposit Account No. 13-0017.

Respectfully submitted,

McANDREWS, HELD & MALLOY, LTD.

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